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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,892	08/28/2003	Shozo Kabeya	116877	7822
25944	7590	01/25/2008		
OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850			EXAMINER DEANE JR, WILLIAM J	
			ART UNIT 2614	PAPER NUMBER
			MAIL DATE 01/25/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/649,892	<b>Applicant(s)</b> KABEYA, SHOZO	
	<b>Examiner</b> William J. Deane	<b>Art Unit</b> 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/ are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 33 – 34 are rejected under 35 U.S. C. 101 because the claimed invention is directed to non-statutory subject matter.

With respect to 25, applicant has not properly claimed the claimed subject matter. For guidance in claiming a computer program see pages 23+ and pages 52 - 55 of the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility provided by the Patent and Trademark Office.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 -34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, there is no discussion of a disconnection unit in the Detailed Description section of the specification. Therefore, the examiner must guess as to applicant's intent. Is the disconnection unit the control unit? If so, please revise the specification or claims for consistency.

In addition, some claims have limitations that lack antecedent basis. For example, in claim 1, there is no antecedent basis for the transmitter/receiver in line 12.

This not meant to be an exhaustive list, but rather an example of the types of problems encountered with the claims...

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,953,322 (Kimball) in view of U.S. Patent No. 5,953,407 (Zhang et al.).

With respect to claims 1 – 3, 5 – 6, 8 – 9, note that Kimball teaches an Network Control Unit (NCU, Fig. 1, communications network 100) capable of inputting/outputting audio signals through a telephone network (Fig. 1), an audio/output path provided in addition to the NCU and capable of inputting/outputting audio signals from/to an outside source (col. 5, lines 21 – 30); A switch unit for switching an output destination of audio signals based on audio input from a transmitter/receiver and an input source of audio signals to be outputted as audio from the transmitter/receiver between the telephone line network and audio input/output unit according to a user (see Col. 3, line 60 – Col. 4, line 4 and Col. 5, lines 10 – 20).

With respect to the “disconnection unit” this could be the NCU unit in Kimball. If this is argued note the call waiting means in Zhang et al. It would have been obvious to

have incorporated such a disconnection unit as taught by Zhang et al. into the Kimball device, as such would only entail the substitution of one disconnection means for another.

With respect to claim 4, note Abstract of Zhang et al.

With respect to claim 6 a switching notification unit, note (Col. 4, lines 1—10).

With respect to claim 7, note the display in Zhang et al. (Fig. 2).


With respect to claims 10 - 11, such a limitation is inherent.

Claims 12 – 32 mirror the claims above and would be rejected in a like manner.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bill Deane whose telephone number is (571) 272-7484. In addition, facsimile transmissions should be directed to Bill Deane at facsimile number (571) 273-8300.

22Jan2008

  
WILLIAM J. DEANE, JR.  
PRIMARY EXAMINER